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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,059	12/09/2003	Tadanobu Shibabuki	Q78807	2969
23373	7590	07/28/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EVANISKO, LESLIE J	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/730,059

Applicant(s)

SHIBABUKI ETAL.

Examiner

Leslie J. Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 8, 10, 13 and 15 is/are rejected.
- 7) ☒ Claim(s) 11 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/10/05 & 12/09/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species IV (Figure 8), claims 8-15, in the reply filed on November 19, 2004 is acknowledged.
2. Claims 1-7 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 19, 2004.

### ***Drawings***

3. The replacement sheet of Figure 8 (now labeled 8A) and the new sheets of Figures 8B-8D of drawings were received on May 10, 2005. These drawings are approved by the Examiner.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 8, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Seto (US 5,156,387). Seto teaches a sucker 100 comprising a main body portion 102 integrally including a mounting base portion and including a suction adherence surface 102b, 108, and a skirt portion 104 attached to the suction adherence surface side of the main body portion 102 and capable of closely corresponding with the sheet member 14, wherein the main body portion has a predetermined stiffness for reducing deformation as recited. Note Figures 3-4 and column 3, line 67 through column 4, line 30, in particular. Additionally, note Seto teaches the skirt portion is comprised of rubber material in column 4, lines 27-29 and rubber material would inherently would have a predetermined resilience. Additionally note that Figure 4 shows the surface of the skirt portion 104 that closely corresponds with the object being gripped is "substantially" parallel to the suction-adherence surface 102b, 108 of the main body 102.

Again, note the claims have been interpreted by the Examiner as being drawn to the sucker device per se and not the combination of the sucker and objects which it is gripping (i.e., the printing plate and protective sheet). Therefore, the number of objects the sucker is able to grip is merely a functional intended use and does not effect the structure of the gripper as recited. Since the sucker of Seto includes all of the structure as recited and is considered to be capable of suction adhering a porous sheet and printing form, it meets the claim language as recited.

With respect to claim 13, note Seto teaches the suction-adherence surface is comprised of materials such as plastic or metal in column 4, lines 24-26. It is noted that any material can be considered to have a surface roughness including minute projections and indentations to some extent. Therefore, the plastic or metal main body portion would inherently include minute protrusions and indentations formed in the surface during the manufacture of the main body portion.

With respect to claim 15, note Seto teaches the skirt portion 104 includes an outer periphery capable of closely corresponding with the sheet 14 being gripped during the suction-adherence operation.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the

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inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seto. Note Seto teaches a gap formed between the suction-adherence surface and the sheet as shown in Figure 4. Clearly the gap formed between the two surfaces will inherently be dependent upon variables such as the resilient force of the skirt, a coefficient of friction between the skirt and sheet, and stiffness of the sheet. It is additionally noted that Seto is silent with respect to whether the gap is specifically set to any desired range as recited. However, it would have been obvious to one of ordinary skill in the art to provide the sucker device of Seto to be configured such that the gap formed between the suction-adherence surface and the sheet being gripped does not allow the sheet to be substantially drawn in toward the suction-adherence surface to better minimize the area of the film that contacts the sucker structure and thereby avoid excessive damage to the sensitive surface of the film sheet.

***Allowable Subject Matter***

9. Claim 9 is allowed.

10. Claims 11 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 9, the prior art of record fails to teach or fairly suggest a sucker including all of the structure as recited, in combination with and particularly including, specifically meeting the set forth relationship between the resilient forces of the skirt portion and the total components of the suction force.

With respect to claim 11, the prior art of record fails to teach or fairly suggest a sucker including all of the structure as recited, in combination with and particularly including, the sucker configured such that the gap formed between the suction adherence surface and the protective sheet satisfies the specific relationship:  $0 \leq t \leq 0.5 \text{ mm}$ .

With respect to claim 16, the prior art of record fails to teach or fairly suggest a sucker including all of the structure as recited, in combination with and particularly including, the suction adherence surface comprising at least one of a sponge and a brush.

***Response to Arguments***

12. Applicant's arguments filed May 10, 2005 with respect to claims 8, 10, 13 and 15 have been fully considered but they are not persuasive of any error in the above rejection. First, applicant argues that the lower surface 102b of Seto is not substantially parallel to the surface of a skirt that closely corresponds with the protective sheet. In particular, applicant points out that the surface of the skirt of Seto is curved to conform to a shape corresponding to the wavy edges of the peripheral wall during suction operation and that the lower surface 102b is a flat surface and therefore the skirt and flat surface are not substantially parallel to one another.

The Examiner disagrees with this argument. Particular attention is invited to Figure 4 of Seto which illustrates that the surface of the skirt portion 104 that closely corresponds to with the protective sheet is in a "substantially" flat horizontal orientation. Furthermore, the suction adherence surface 102b is also in a flat horizontal orientation. Therefore, the sucker of Seto meets the claim language as recited. The deformation described in Seto with respect to the skirt in order to correspond to the wavy edges of the sucker main body would not change the orientation of the skirt such that the surface closely corresponding to the protective sheet is not "substantially" parallel to the suction adherence surface.

With respect to claim 10, applicant argues that Seto does not provide any motivation for setting a gap size since Seto does not recognize that the gap size



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has any effect on whether a sheet object being suctioned will be drawn in towards the suction adherence surface. Applicant goes on to state that outside of the present disclosure, the Examiner has failed to establish that gap size is important to the prior art. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is the Examiner's position that one of ordinary skill in the art would recognize the importance of providing some gap between the suction adherence surface and the sheet being adhered to insure proper suctioning operation of the sucker and to insure minimal contact between the sucker structure and the surface of the sheet to prevent damaging the sensitive surface of the photographic film member of Seto. Furthermore, it is noted that the broad language of claim 10 only requires the gap be set to some range and does not provide any specific values or limits to that range. Therefore, it is the Examiner's position that Seto renders obvious the sucker as broadly recited in claim 10.

In view of the above reasoning, the Examiner is not persuaded of any error in her rejections.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
July 25, 2005